



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/576,456	12/22/2006	Paul Joseph Bingham	18801-00789	2426

7590 12/22/2010
Robert H Earp III
McDonald Hopkins Co
600 Superior Avenue East
Suite 2100
Cleveland, OH 44114-2653

EXAMINER

LARSON, JUSTIN MATTHEW

ART UNIT	PAPER NUMBER
----------	--------------

3782

MAIL DATE	DELIVERY MODE
-----------	---------------

12/22/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/576,456	Applicant(s) BINGHAM, PAUL JOSEPH	
	Examiner Justin M. Larson	Art Unit 3782	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 12, 14-16 and 18-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12, 14-16 and 18-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 May 2010 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/22/10 has been entered.

Priority

2. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Australia on 10/20/03. It is noted, however, that applicant has not filed a certified copy of the foreign application as required by 35 U.S.C. 119(b).

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the eyelet being open ended, as now recited in claim 1, must be shown or the feature(s) canceled from the claim(s). Figure 1 of the present Application is a sectional view of Applicant's invention. The eyelet as a whole is never shown to be open ended. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate

Art Unit: 3782

prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: nowhere in the originally filed disclosure is the term “open ended” set forth.

Claim Rejections - 35 USC § 112

5 The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6 Claims 1-10, 12, 14-16, and 18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains

subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Nowhere in the originally filed specification is the eyelet (21) disclosed as being "open ended" as now recited in claim 1. While Figure 1 appears to show an "open ended" element (21), this figure is plainly disclosed as being a sectional view of Applicant's invention such that this figure is only showing half of the eyelet (21), where eyelet (21) as seen in the remaining non-sectional figures is clearly not "open ended" as Applicant seems to contend.

7 The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8 Claims 1-10, 12, 14-16, and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The scope of the limitation "open ended" in claim 1 is not clear as Applicant has not shown or disclosed the eyelet (21) being open ended. To the degree that Applicant feels support for this limitation can be found in Figure 1, which shows a sectional view of eyelet (21), Examiner is interpreting this scope of this limitation to include any element that is "open ended" when viewed in a sectional view.

Claim Rejections - 35 USC § 102

9 The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 3782

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 19-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Grim (US 5,366,128 A).

Regarding claim 19, Grim discloses a support assembly to secure a roof bar to a vehicle, said assembly comprising: a base (11) capable of securing the roof bar (12) to the vehicle roof; and a cover (24) pivotably mounted on the base at a pivot point (23), wherein the pivot point is moveable along the base from a first position to a second position (23 moves as 41 slides along 26).

Regarding claim 20, there is a track (44) located on a first and second side of the base, the cover capable of sliding along the track (43 within 44) to move from the first position to the second position.

Regarding claim 21, there is a lock (47) operatively associated with the base and cover to secure the cover to the base and operable to release the cover for sliding along the track.

11. Claims 22-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Poulet (FR 2832371 A).

Regarding claim 22, Poulet discloses a support assembly to secure a roof bar to a vehicle roof, having a longitudinal mounting portion (11/13) via which articles are secured to the bar, said assembly comprising: a base (15) capable of securing the bar to the vehicle roof; a cover (45) mounted on the base, wherein the cover is moveable relative to the base from a first position (Figure 5) to a second position (Figure 4) while remaining mounted to the base; and wherein in the first position articles are prevented

Art Unit: 3782

from being secured to the bar and wherein in the second position articles are capable of being secured to the bar.

Regarding claim 23, the cover includes a pivot joint (46), and the cover is pivotally mounted to the base at the pivot joint.

Regarding claim 24, the cover is slidable (broadly taken to mean capable of moving or passing smoothly, where pivoting movement can be considered a smooth moving or passing motion) relative to the base from the first position to the second position.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1-5, 7-10, 12, and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stemmler (EP 694441 A1) in view of Gerber (US 5,002,216 A).

Examiner notes that the claims as currently presented positively claim only the subcombination support assembly where any mention of the roof bar is purely functional.

Regarding claim 1, Stemmler discloses a support assembly including: a base (3a) as claimed; a user manipulated part (12/14) including a threaded portion (in 14), a securing member (14) connected to said threaded portion; and a threaded shaft (of 12) to engage said threaded portion; a movable cover (17) as claimed; and a lock (18) as

Art Unit: 3782

claimed; wherein said securing member is tensioned to inhibit relative movement between the vehicle and the assembly.

Stemmler fails to disclose the securing member including an open ended eyelet for engaging a vehicle roof. The securing member of Stemmler is a solid body meant to be movably positioned within a groove (13) of the roof.

Gerber, however, teaches (Figure 14) that it was already known in the art for a securing member (430) to include an eyelet (432) for engaging pins (433) of the roof and a means (424) for preventing disengagement of the openings and pins. When viewed in a sectional view, the eyelet (432) of Gerber is open ended to the same degree Applicant has shown in Figure 1. Also, Gerber teaches an eyelet (234) that is open ended even when viewed in a non-sectional view.

One of ordinary skill in the art, after studying Stemmler and Gerber, would have realized, through their own available knowledge and reasoning, that a securing member could either be movably positioned within a groove of the roof or could include a eyelets for engaging pins of the roof and that such securing member-to-roof fastening means would be reasonably expected to work in place of one another for securing a roof bar to a vehicle roof. As such, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the securing member (14) of Stemmler with eyelets and the roof of Stemmler with pins, as a mere substitution of known securing member-to-roof fastening means. The manipulated part (12) of this modified Stemmler design would effectively provide the means for preventing disengagement of the eyelets and pins by biasing the pins into the smaller parts of the

Art Unit: 3782

openings. The eyelet and pin design would be less likely to inadvertently slide with respect to the length of the vehicle roof. A series of pins could also be provided on the roof in order to allow positional adjustment of the roof bar along the length of the vehicle roof.

Regarding claim 2, the cover is attached to the base (Figures).

Regarding claim 3, the cover is releasable for pivoting movement about an axis (can pivot about 17a as it is removed if a user so pivots) and along a predetermined path (arcuate patch through which end of cover moves).

Regarding claim 4, the axis is generally horizontal (Figures).

Regarding claim 5, the path is located in a vertical plane (arcuate path mentioned above passes through a vertical plane).

Regarding claim 7, the lock includes a lock cylinder (Figures).

Regarding claim 8, the base has a cavity (3c is shown recessed) via which a user has access to the part (12).

Regarding claim 9, the movement of the shaft causes the engagement and disengagement of the eyelets and pins.

Regarding claim 10, the longitudinal axis of the shaft is generally vertical (Figures).

Regarding claim 12, the securing member is a strap assembly including a strap body (14) to the extent claimed.

Regarding claim 14, the lock cylinder is key operable (Figures).

Regarding claim 15, Stemmler discloses a mounting adapter (14).

Regarding claim 16, Stemmler discloses a securing member (8).

14. Claims 1-10, 14, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmidt et al. (DE 4315029 A1) in view of Stemmler, further in view of Gerber.

Examiner notes that the claims as currently presented positively claim only the subcombination support assembly where any mention of the roof bar is purely functional.

Regarding claim 1, Schmidt discloses a support assembly including: a base (2) as claimed; a user manipulated part (9) including a threaded shaft; a movable cover (4) as claimed; and a lock (6) as claimed.

Schmidt fails to disclose the manipulated part including a securing member connected to a threaded portion and having an open ended eyelet for engaging the vehicle roof. The manipulated part of the Schmidt is simply a screw inserted into an aperture in the vehicle roof.

Stemmler, however, teaches that it was already known for a screw to engage a securing member (14) having a threaded portion, where the securing member engages the vehicle instead of the screw. Gerber teaches (Figure 14) that it was already known in the art for a securing member (430) to include an eyelet (432) for engaging pins (433) of the roof and a means (424) for preventing disengagement of the openings and pins. When viewed in a sectional view, the eyelet (432) of Gerber is open ended to the same degree Applicant has shown in Figure 1. Also, Gerber teaches an eyelet (234) that is open ended even when viewed in a non-sectional view.

One of ordinary skill in the art, after studying Schmidt and Stemmler, would have realized, through their own available knowledge and reasoning, that a mounting screw could either directly engage a vehicle roof or could be connected to a securing member that engages a vehicle roof. As such, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have attached a securing member to the user-manipulated part (9) of Schmidt for engagement with the vehicle roof as a mere substitution of known securement means.

One of ordinary skill in the art, after studying Stemmler and Gerber, would have realized that a securing member could either be movably positioned within a groove of the roof or could include an eyelet for engaging pins of the roof and that such securing member-to-roof fastening means would be reasonably expected to work in place of one another for securing a roof bar to a vehicle roof. As such, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the securing member of the modified Schmidt assembly with eyelets and the roof of the modified Schmidt assembly with pins, as a mere substitution of known securing member-to-roof fastening means. The manipulated part (9) of this modified Schmidt design would effectively provide the means for preventing disengagement of the openings and pins by biasing the pins into the smaller parts of the openings.

Regarding claim 2, the cover is attached to the base (Figures).

Regarding claim 3, the cover is releasable for pivoting movement about an axis (through 3c) and along a predetermined path (arcuate patch through which end of cover moves).

Art Unit: 3782

Regarding claim 4, the axis is generally horizontal (Figures).

Regarding claim 5, the path is located in a vertical plane (arcuate path mentioned above passes through a vertical plane).

Regarding claim 6, the movement is provided by projections (4c) on said cover slidably engaged in tracks (3c) on said base.

Regarding claim 7, the lock includes a lock cylinder (Figures).

Regarding claim 8, the base has a cavity (between 2a) via which a user has access to the part (9).

Regarding claim 9, the movement of the shaft causes the engagement and disengagement of the eyelets and pins.

Regarding claim 10, the longitudinal axis of the shaft is generally vertical (Figures).

Regarding claim 14, the lock cylinder is key operable (Figures).

Regarding claim 18, Schmidt discloses a roof bar (1) having a mounting portion (1a) with a flange (Figures).

Response to Arguments

15. Applicant's arguments filed 11/22/10 have been fully considered but are not found to be persuasive. Applicant has asserted that eyelet (432) of Gerber is not "open ended" as now recited in claim 1. Examiner notes that Applicant's own eyelet (21) is also not open ended. Both Applicant's eyelet (21) and Gerber's eyelet (432) are closed-loop structures, as can be seen in Applicant's Figure 3 and Gerber's Figure 14.

Applicant's Figure 1 is plainly disclosed as a sectional view of Applicant's invention

Art Unit: 3782

where it is clear that while the figure appears to show an open ended eyelet (21), the figure is only showing half of the eyelet structure.

Conclusion

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin M. Larson whose telephone number is (571)272-8649. The examiner can normally be reached on Monday-Friday, 9a-5p (EST). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J. Newhouse can be reached on (571) 272-4544. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Justin M Larson/
Primary Examiner, Art Unit 3782
12/19/10